

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hermkens, Pedro Harold Han et al.

Application No.: 10/534,945

Conf. No.: 1701

Filed: May 6, 2005

Art Unit: 1625

For: INDOLES USEFUL IN THE TREATMENT OF
ANDROGEN-RECEPTOR RELATED
DISEASES

Examiner: Morris, Patricia L.

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action dated February 1, 2008 having a shortened statutory one-month period for response which expires on March 1, 2008.

In response to this Action restricting the claims as follows:

Group I	Claims 1-15 and 17, drawn to indole compounds and compositions of the compounds of the formula recited in claim 1 wherein R ¹ and R ² are phenyl
Group II	Claims 1-15 and 17, drawn to indole compounds and compositions of the compounds of the formula recited in claim 1 wherein R ¹ is phenyl and R ² is pyridyl
Group III	Claims 1-15 and 17, drawn to indole compounds and compositions of the compounds of the formula recited in claim 1 wherein R ¹ is pyridyl and R ² is phenyl

Group IV	Claims 1-15 and 17, drawn to indole compounds and compositions of the compounds of the formula recited in claim 1 wherein R ¹ is pyrimidine and R ² is phenyl
Group V	Claims 1-15 and 17, drawn to indole compounds and compositions of the compounds of the formula recited in claim 1 wherein R ¹ is pyrazine and R ² is phenyl
Group VI	Claims 1-15 and 17, drawn to indole compounds and compositions that are not defined in Groups I to V
Group VII	Claims 18-20, drawn to multiple uses of treatment with the indole compounds and compositions thereof

Applicants hereby elect without traverse, although Applicants disagree with the Examiners characterization of the complexity of the claims, to prosecute the claims of Group III, *i.e.*, claims 1-15 and 17 directed to indole compounds and compositions of the compounds of the formula recited in claim 1 wherein R¹ is pyridyl and R² is phenyl. Further, with respect to the requirement to elect a single disclosed species from the allegedly patentably distinct species, Applicants hereby request examination of the claims electing the species of 3-(2-Nitro-phenylsulfanyl)-1-pyridin-2-ylmethyl-1H-indole-6-carbonitrile monohydrochloride which is recited in claim 9 and further disclosed as compound 120 in Example 25 at page 58 and 59 of the specification. The elected species, 3-(2-Nitro-phenylsulfanyl)-1-pyridin-2-ylmethyl-1H-indole-6-carbonitrile monohydrochloride, is readable on claims 1-15 and 17.

In addition, in response to the Examiner's request that when either one of Groups I, II, III, IV, V, or VI is elected to elect one method of use, *i.e.* a specific disease, Applicants elect with traverse the species of a method of treating androgen receptor related diseases, more specifically BPH (benign prostate hyperplasia). According to the Examiner in a national stage application claims drawn to a product and a process of use of said product are considered as one combination of different categories of invention having unity of invention. The Examiner, however, further states that unity of invention might not be present if the application contains claims to more or less than


one such combination. Applicants submit that the Examiner's request and reasoning are inconsistent with the Examiner's assertion that Group VII drawn to uses of the compounds and compositions in Groups I to VI constitutes a separate patentably distinct invention. Accordingly, Applicants request that the Examiner's request to elect one method of use, *i.e.* a specific disease should be withdrawn.

Applicants expressly reserve the right to file a divisional application encompassing the claims of non-elected Groups I, II, and IV to VII prior to issuance of this application.

An Action on the merits is respectfully requested.

Dated: February 28, 2008

Respectfully submitted,

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